

## **R e m a r k s**

### **Formalities**

Typographical errors in the Applicants names exists as recognized in the first page of the "Office Action Summary" and in the Filing Receipt. As provided in the Declaration, a copy of which is attached:

I) a "u" should be replaced with an "o" for the Applicant "Kenneth J. Rothschild" and not "Kenneth J. Ruthschild" and

II) a "rn" should be replaced with an "m" for the Applicant "Sergey Marneav" and not "Sergey Marurneav".

### **Claim Rejections**

I) Claim 31, 43, 55, and 67 are rejected under 35 U.S.C 112, second paragraph a being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

II) Claims 21-68 are rejected on the basis of 35 U.S.C. 102(e) in light of U.S. Patent No. 6,303,337 and U.S. Patent No. 6,306,628;

III) Claims 21-68 are provisionally rejected on the basis of the judicially created doctrine of obviousness-type double patenting and Claims 21-68;

#### **I) Rejection under 35 U.S.C 112, second paragraph**

We disagree that Claims 31, 43, 55, and 67 do not satisfy 35 U.S.C 112, second paragraph; however, in order to further prosecution and in no way acquiescing to the Examiners rejection, expressly reserving the right to prosecute the same or similar claims, we have amended Claims 31, 43, 55, and 67 to comply with the expression "selected from the group consisting of" as requested by the Examiner.

#### **II) Rejection under 35 U.S.C 102(e)**

Claims 21-68 stand rejected on the basis of 35 U.S.C. 102(e) in light of U.S. Patent No. 6,303,337 and U.S. Patent No. 6,306,628. However, it appears that the Examiner has misunderstood the term "gel-free" - perhaps confusing it with "cell-free." Applicants have noted that the Examiner cites to the abstracts of both U.S. Patent No. 6,303,337 and U.S. Patent No. 6,306,628 to support the rejection. Neither abstract mentions "gel-free" - but does mention "cell-free."

Both U.S. Patent No. 6,303,337 and U.S. Patent No. 6,306,628 teach "cell-free" translation systems - but not "gel-free" detection. The Examiner is requested to note that the

specifications of both U.S. Patent No. 6,303,337 and U.S. Patent No. 6,306,628 have examples up through Example 22. In these examples, detection is performed with SDS-PAGE, i.e. a gel system. By contrast, the specification of the present application contains examples beyond Example 22, and in particular, Example 25 which teaches gel-free detection using microtiter plates in an ELISA format (Claim 29 has been amended to specifically track this embodiment).

Moreover, the present application is the national entry from International Application No. PCT/US00/23233 - which claims the benefit of nonprovisional Application No. 09/382,950 now U.S. Patent 6,303,337, filed August 25, 1999, and Application No. 09/382,736 now U.S. Patent 6,306,628, filed August 25, 1999. Example 25 was added at the time the PCT was filed.

In view of the above, the rejection cannot stand. The Examiner is respectfully asked to withdraw it.

### **III) Double Patenting**

Claims 21-68 stand provisionally rejected on the basis of the judicially created doctrine of obviousness-type double patenting. As provided in MPEP Section 804 Definition of Double Patenting Section B. Between Copending Applications Provisional Rejections, "[t]he 'provisional' double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that 'provisional' double patenting rejection is the only rejection remaining in one of the applications. If the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent."

It is believed that the other rejections have been overcome. Therefore, the provisional double patenting rejection should be withdrawn and the case should proceed to issuance.

**CONCLUSION**

Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that these grounds for rejection be withdrawn for the reasons set forth above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616

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